

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAJESH RENGARAJAN et al.

Appeal No. 2001-2080
Application 09/000,626

MAILED

NOV. 22 2002

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AND INTERFERENCES

ORDER REMANDING TO EXAMINER

An Examiner's Answer was entered into the record on January 29, 2001 (Paper No. 25). On Page 3 of the Examiner's Answer, the examiner cites the reference JP 57-159038 as prior art. The record, however, does not contain an English language translation of the complete reference.

Additionally, clarification is required with regard to the 35 U.S.C. 112, 1st paragraph, rejection of claims 2 through 5, claim 7, and claim 25. It appears that the Final

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Rejection entered on April 5, 2000 (Paper No. 19) only rejected claims 1 and 24 under 35 U.S.C. 112, 1st paragraph, whereas the Examiner's Answer entered on January 29, 2001 (Paper No. 25) included the rejection of claims 2 through 5, claim 7 and claim 25, along with claims 1 and 24, in this rejection. The inclusion of the additional claims in the rejection constitutes a new ground of rejection, which is not permitted.

Lastly, Amendment C filed on August 2, 1999 (Paper No. 16) appears to be entered as "Amendment B." Correction of the physical entry of Amendment C is required.

Accordingly, it is

ORDERED that the application be remanded to the examiner for obtaining an English language translation of the complete reference JP 57-159038 to be placed in the record and submitting a copy of the translation to applicants, clarification with regard to the 35 U.S.C. 112, first paragraph, rejection of claims 2 through 5, claim 7 and claim 12, correction of the physical entry of Amendment C, and for any further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

**BOARD OF PATENT APPEALS
AND INTERFERENCES**



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